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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,366	12/12/2003	Gerard R. Lazo	0094.03	2526

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USDA-ARS-OFFICE OF TECHNOLOGY TRANSFER  
PATENT ADVISORS OFFICE  
WESTERN REGIONAL RESEARCH CENTER  
800 BUCHANAN ST  
ALBANY, CA 94710

EXAMINER
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KIM, PAUL

ART UNIT	PAPER NUMBER
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2161

MAIL DATE	DELIVERY MODE
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09/24/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/734,366

Applicant(s)

LAZO ET AL.

Examiner

Paul Kim

Art Unit

2161

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 31 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 31 August 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: See Continuation Sheet.

  
APU MOFIZ  
SUPERVISORY PATENT EXAMINER

Continuation of 13. Other: Applicant's arguments filed 31 August 2007 have been fully considered but are found unpersuasive

i. Claims Rejections under 35 U.S.C. 102

Applicant asserts the argument that Imachi is silent and fails to disclose "a multidimensional display comprising a figure having loci distributed about the periphery thereof" and "plotting a symbol for each cluster within the multidimensional figure based on a set of coordinates within said multi-dimensional display" (See Amendment, page 9).

As per Applicant's assertion that Imachi is silent and fails to disclose "a multidimensional display comprising a figure having loci distributed about the periphery thereof" and "plotting a symbol for each cluster within the multidimensional figure based on a set of coordinates within said multi-dimensional display," the Examiner disagrees. Applicant is directed to column 4, lines 11-21 of Imachi which discloses the following:

"When there are provided two document groups (document groups A and B), document groups A and B are plotted on one axis and the other axis, respectively, and the relevance degree between a document i of document group A and a document j of the document group B is indicated at a coordinate (i, j) with an indication type according to the relevance degree. By displaying the relationship between the documents in the two-dimensional coordinate system, it is possible to grasp at a glance the characteristics of the document groups such as the relationship between document groups as a whole or between individual documents."

Applicant is further directed to Figures 3-4, 8-10, and 12-15 of Imachi which disclose display examples of clustering in a two-dimensional coordinate system. Wherein elements of a document are clustered on a two-dimensional coordinate system, it is unclear to the Examiner, how the resulting cluster would not be considered "a multidimensional figure based on a set of coordinates." One of ordinary skill in the art would clearly understand that a plotting of elements on a two-dimensional display to create clusters would read upon Applicant's claimed invention.

Additionally, in response to applicant's arguments against the references individually (i.e. See Amendment, page 9, "Imachi is also completely silent with respect to disclosure of 'contigs' and 'EST data'"), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). While it may not be surprising to the Applicant that Imachi is "completely silent with respect to disclosure of 'contigs' and 'EST data'," the Examiner notes that Imachi, in combination with Karchi, appropriately and fully discloses Applicant's invention as claimed.

For the aforementioned reasons above, the claims rejections under 35 U.S.C. 102(e) are sustained and deemed proper.

ii. Claims Rejections under 35 U.S.C. 103

Applicant asserts the argument that there is no suggestion or motivation to modify the reference teachings (See Amendment, page 10). Applicant asserts the argument that the cited reference does not provide a reasonable expectation of success (See Amendment, page 11).

Applicant asserts the argument that the reference fails to teach all of the claimed elements (See Amendment, page 11).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicant is directed to the motivation provided in the earlier Office action dated 13 June 2006. That is, "one of ordinary skill in the art would have been motivated to do this modification so that an overall visual representation of data (specifically, ESTs and contigs) may be presented by plotting data which have been gathered and clustered by common attributes." In response to applicant's argument that Karchi is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Karchi discloses the use of EST databases and contigs in identifying inter-contig regions. Accordingly, wherein Imachi and Karchi both provided method for visualizing relationships between and among data, the cited prior art would be analogous art.

As per Applicant's assertion that the cited reference does not provide a reasonable expectation of success, since the cited prior art are deemed analogous art, Applicant's argument is deemed moot.

As per Applicant's assertion that the reference fails to teach all of the claimed elements, Applicant has not asserted any specific prior art arguments in response to the rejections of the claims but has applied a piecemeal analysis of the disclose prior art. Therefore, by virtue of dependency, the rejections of the claims under 35 U.S.C. 103 are sustained for the reasons stated above in relation to the rejections of claims under 35 U.S.C. 102.